

REMARKS

Applicant appreciates the Examiner's attention to this Application. Applicant respectfully notes that the prior rejections under 35 U.S.C. §102 and 35 U.S.C. §103 have been withdrawn, and that Claim 22 has been allowed.

Applicant has amended Claims 2, 3, 39, 42, 43 and 47; Claims 48 and 49 are new. Applicant is not conceding in this Application that the amended claims are not patentable, as the present claim amendments are only for facilitating expeditious prosecution of the allowable subject matter noted by the Examiner. Applicant respectfully reserves the right to pursue these and other claims in one or more continuation or divisional patent applications.

I. STATUS OF THE CLAIMS

At the time of the Office Action, claim 41 has been cancelled. Claims 1-40 and 42-47 are pending in the application. Claims 1, 4-7, 10-21, 23-38, 40 and 46 have been withdrawn. Claim 22 has been allowed.

Claims 2, 3, 42 and 43 are objected to because of informalities. Claims 2, 8, 39 and 47 are rejected under 35 U.S.C. 112, first paragraph, for the alleged reason that the specification does not enable any person skilled in the art to make or use the invention commensurate with the scope of the claims.

II. OBJECTIONS TO THE CLAIMS

Claims 2, 3, 42 and 43 are objected to because of informalities. Applicants have amended claims 2, 3, 42 and 43 in accordance with the Examiner's recommendations. Applicant respectfully requests reconsideration and withdrawal of the objections.

In claim 2, the phrase "wherein at least one of the said two or more *cis*-acting elements consists of a nucleotide sequence of SEQ ID NO: 11" has been amended to "wherein at least one of the said two or more *cis*-acting elements consists of [[a]] the nucleotide sequence of SEQ ID NO: 11." As the objected language has been removed, Applicant respectfully requests the Examiner withdraw the objection to claim 2.

In claim 3, the phrase "wherein at least one of the said two or more *cis*-acting elements consists of a nucleotide sequence of SEQ ID NO: 11" has been amended to "wherein at least one of the said two or more *cis*-acting elements consists of [[a]] the nucleotide sequence of SEQ ID NO: 11." As the objected language has been removed, Applicant respectfully requests the Examiner withdraw the objection to claim 3.

In claim 42, the phrase "wherein at least one of the said two or more *cis*-acting elements consists of a nucleotide sequence of SEQ ID NO: 11" has been amended to "wherein at least one of the said two or more *cis*-acting elements consists of [[a]] the nucleotide sequence of SEQ ID NO: 11." As the objected language has been removed, Applicant respectfully requests the Examiner withdraw the objection to claim 42.

In claim 43, the phrase "wherein at least one of the said two or more *cis*-acting elements comprises two nucleotide sequences of SEQ ID NO: 11 and two nucleotide sequences of SEQ ID NO: 7" has been amended to "wherein at least one of the said two or more *cis*-acting elements comprises two copies of the nucleotide sequence[[s]] of SEQ ID NO: 11 and two copies of the nucleotide sequence[[s]] of SEQ ID NO: 7." As the objected language has been removed, Applicant respectfully request the Examiner withdraw the objection to claim 43.

The Office Action Summary lists Claims 44 and 45 as objected to. However, the

Office Action does not explain the basis for the objections. Applicant assumes Claims 44 and 45 are objected to because they depend on Claim 43, which was the subject of an objection. As the objection to Claim 43 has been satisfied, the objections to Claims 44 and 45 have been satisfied. Applicant respectfully requests the Examiner withdraw the objections to Claims 44 and 45.

III. REJECTION OF CLAIMS 2, 8, 39 AND 47 UNDER 35 U.S.C. §112

Claims 2, 8, 39 and 47 are rejected under 35 U.S.C. 112, first paragraph, for the stated reason that the specification does not enable any person skilled in the art to make or use the invention commensurate in scope with the claims. The Examiner states in the Office Action on pages 3-4:

...the specification, while being enabling for a chimeric promoter capable of mediating local gene expression in plants upon pathogen infection wherein the promoter comprises at least one element consisting of SEQ ID NO: 11 and induction is between 10 and 15 fold and a chimeric promoter capable of mediating local gene expression in plants upon pathogen infection wherein the promoter comprises either two elements consisting of SEQ ID NO: 11 or the promoter comprises the combination of one copy of SEQ ID NO:11 followed by one copy of SEQ ID NO:7 or 4 copies of SEQ ID NO: 11 followed by four copies of SEQ ID NO:7 and induction is greater than 15 fold, does not reasonably provide enablement for any other embodiment.

Applicant does not agree that the Specification is non-enabling for other embodiments of the invention. However, Applicant offers the following amendments solely for the purpose of facilitating expeditious prosecution of the embodiments which the Examiner has stated are enabled.

Claims 2, 8, 39 and 47 have been amended to incorporate the Examiner's enumerated elements. Claim 2 (on which Claim 8 depends) has been amended to claim a chimeric promoter comprising SEQ ID NO: 11 wherein the induction of local gene

expression is between 10 and 15-fold. Claim 39 has been amended to claim the following embodiments: a chimeric promoter comprising SEQ ID NO: 11 wherein induction of local gene expression is between 10 and 15-fold, a chimeric promoter comprising two copies of SEQ ID NO: 11 wherein induction of local gene expression is at least 15-fold, and a chimeric promoter comprising one copy of SEQ ID NO: 11 and one copy of SEQ ID NO: 11 and one copy of SEQ ID NO: 7 wherein induction of local gene expression is at least 15-fold. Claim 47 has been amended into independent form, and now claims the following embodiments: a chimeric promoter comprising two copies of SEQ ID NO: 11, a chimeric promoter comprising of the combination of one copy of SEQ ID NO: 11 and one copy of SEQ ID NO: 7, and chimeric promoter comprising of four copies of SEQ ID NO: 11 and four copies of SEQ ID NO: 7.

As Applicant has amended to claims to recite only those embodiments the Examiner believes to be enabled by the Specification, Applicant respectfully submits that the rejection is now moot. As such, Applicant respectfully requests the Examiner reconsider and withdraw the rejections and allow the claims.

IV. CONCLUDING REMARKS

For at least the reasons set forth above all currently pending claims are believed to be patentably distinct from the prior art. Applicant respectfully requests the Examiner reconsider and withdraw all rejections, and allow all claims.

A petition for a one-month extension of time under 37 C.F.R. §1.136 and a Request for Continued Examination accompany this paper. Authorization is given to charge the appropriate fees, charge any other necessary fees and credit any overpayments to Deposit Account No. 50-0951.

This submission is believed to be fully responsive to the Examiner's request. The application is believed to be in condition for immediate allowance. If any issues remain outstanding, Applicant invites the Examiner to call the undersigned if it is believed that a telephone interview would expedite the prosecution of the application to an allowance.

Respectfully submitted,

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